

REMARKS

The present application was filed on January 12, 2004 with Claims 1 through 56. Claims 1-9, 29-37, and 57-62 are presently pending in the above-identified patent application (i.e., prior to entry of this amendment). Claims 10-28 and 38-56 have previously been withdrawn from consideration. Claims 1, 6, 29, 34, 58, 59, 61 and 62 have been amended. Claims 57 and 60 have been canceled, without prejudice.

In the Office Action, the Examiner rejected Claims 1-5, 9, 29-33, 37, 57 and 60 under 35 U.S.C. § 103(a) as allegedly being unpatentable over a proposed combination of McElhatten et al. (United States Patent No. 7,073,189)("McElhatten"), Hrastar et al. (United States Patent No. 6,272,150)("Hrastar"), and Menard et al. (United States Publication No. 2002/0177428)("Menard"); and rejected claims 6-8, 34-36, 58-59, and 61-62 under 35 U.S.C. § 103(a) as allegedly being unpatentable in view of a proposed combination of McElhatten, Hrastar, Menard, and Lu (United States Publication No. 2002/0157115)("Lu").

Applicants and applicants' undersigned representative thank Examiner Zhong for the effort taken in preparing the instant office action. Applicants respectfully traverse each and every rejection of the Examiner, as applied to the amended claims. The amendment of the claims and the remarks set forth herein are presented in a sincere effort to advance the case to allowance.

Applicants respectfully request that the Examiner exercise discretion to grant the courtesy of a telephonic interview and will telephone the Examiner regarding same.

This paper is submitted pursuant to 37 CFR § 1.116 and should be entered. The amendments and remarks place all of the pending claims, i.e., Claims 1-9, 29-37, 58, 59, 61 and 62, in a form that is believed allowable, and, in any event, place the case in a better form for appeal. It is believed that examination of the pending claims, which are consistent with the previous record herein, will not place any substantial burden on the Examiner.

The amendments and cancelations herein are made in an effort to advance prosecution of this case, and applicants do not necessarily concede that the claims pending prior to this amendment are not patentable over the art of record. Applicants

respectfully reserve the right to file one or more continuing applications with claims of scope comparable to those of the pending claim set prior to entry of this amendment, as well as with other claims.

Support for the amendments may be found, for example, at 10:15 through 14:15 of the specification. No new matter has been added.

Independent Claims 1 and 29

Claim 1 has been amended to: (i) positively claim a digital cable host device, a point-of-deployment module, a communications network, and a database, in addition to the previously-claimed server and interface, and (ii) clarify characteristics of the claimed elements and their inter-relationships. Since Claim 1 now includes the point-of-deployment module, these remarks are directed to the proposed combination of McElhatten, Hrastar, Menard, and Lu. Applicants respectfully assert that (i) the proposed combination is improper, and that (ii) even if combined, these four references fail to teach or suggest all claim limitations, as required by MPEP 2143.03.

The Proposed Combination of McElhatten, Hrastar, Menard, and Lu is Improper

In view of the recent decision by the Supreme Court in *KSR International Co. v. Teleflex Inc. (KSR)*, 82 USPQ2d 1385 (2007), the PTO has developed examination guidelines for determining obviousness under 35 U.S.C. 103. MPEP 2141. MPEP 2143 sets forth exemplary rationales that may support a conclusion of obviousness, including (A) combining prior art elements according to known methods to yield predictable results; (B) simple substitution of one known element for another to obtain predictable results; (C) use of known technique to improve similar devices (methods, or products) in the same way; (D) applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art; and (G) some teaching,

suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Here, it is applicants' understanding that the Examiner is relying on point (G). In particular, the Examiner alleges, at the bottom of page 3 of the instant Office Action, that it "would have been obvious to one having ordinary skill in the art at the time the invention was made to provide alerting operator as taught by Hrastar to the set top terminal of McElhatten in order to provide the user of the network management station is empowered to make better decisions regarding causes and effect of anomalies in the network, as well as improving the understanding of the network for growth planning, potential failure scenarios, routing diagnostic tests, maintenance and the like," citing 3:30-40 of Hrastar. Applicants respectfully traverse this assertion. The heartbeat in McElhatten 10:30-42 teaches *ceasing transmission* of a *television program* when a terminal stops sending heartbeats, because the terminal has simply been turned off in *normal operation*. There is no motivation to combine this heartbeat function with the complex *cable modem map* of Hrastar.

The Examiner further alleges, at page 4 of the instant Office Action, that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have verified alarm as taught by Menard to the set top terminal of McElhatten as modified by Hrastar in order to provide an improved system that reduces the costs associated with false alarms," citing [0008] of Menard. Applicants respectfully disagree. Menard is directed to *burglar and fire alarms*. The desire to *reduce false burglar and fire alarms* is unconnected with the *cable television system* of McElhatten and the *cable modem monitoring system* of Hrastar. The Examiner's attention is respectfully drawn to MPEP 2141.01(a), which points out that to rely on a reference under 35 U.S.C. 103, it must be *analogous* prior art – burglar and fire alarms are in a different field of endeavor than cable television, and the Examiner has pointed to nothing in the McElhatten or Hrastar inventions that identify anything analogous to a false alarm as being problematic.

Indeed, prior to applicants' invention, the POD module has been focused on providing security measures for a cable operator; there has simply not been any

concern with security for the end-user's equipment in a cable network. Specification 6:23-7:1. It is true that "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on *hindsight* reasoning, . . . so long as it takes into account *only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.*" *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971), *cited in* MPEP 2145 at 2100-167. However, applicants respectfully assert that the proposed combination of McElhatten, Hrastar, and Menard is a case of *improper hindsight*, wherein the burglar and fire alarm aspects of Menard are included by the Examiner only because of the knowledge of use of the POD module for end-user oriented security in a cable network, as first disclosed in the instant specification.

Yet further, the Examiner alleges, at page 6 of the Office Action, that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide POD module as taught by Lu to the set top terminal of McElhatten in order for electronic apparatuses that may be inserted into or attached to a standard consumer electronic system to thereby enable the standard consumer electronic system to perform enhanced, non-standard applications," citing [0005] of Lu. Applicants respectfully assert that the proposed combination of McElhatten, Hrastar, Menard, and Lu is improper, since the rationale mentioned by the Examiner would not teach, suggest, or motivate the skilled artisan to combine McElhatten, Hrastar, and Menard with Lu to obtain the presently claimed invention, directed to *security from the perspective of a user*. Lu teaches the use of a POD for *e-mail and video games*.

Even if Combined, the Proposed Combination of McElhatten, Hrastar, Menard, and Lu Fails to Teach or Suggest Every Limitation of Claims 1 and 29

The references of record, even if combined as proposed by the Examiner, fail to teach or suggest every limitation of Claim 1. For example, the references, even if combined, fail to teach or suggest *a database associated with the server, the database comprising a record with contact information for a user of the digital cable host device together with the information identifying the device, the database being populated based*

on an authorization process for the digital cable host device and the point-of-deployment module. Paragraph 0075 of Menard, cited by the Examiner, merely discusses making a conventional voice call to the user of an alarm such as a burglar or fire alarm.

The references of record, even if combined as proposed by the Examiner, fail to teach or suggest that *the server generates an alert to prompt an operator of the communications network to contact the user of the device if it is determined that the second signal is not received within the period, the alert including the contact information for the user from the database, the contact information being identified based on the information identifying the device.*

Claim 29 has been amended to recite limitations similar to those of Claim 1, and is accordingly also patentable. Thus, in addition to the impropriety of the proposed combination of references, the references of record, even if combined, fail to teach or suggest *accessing a database comprising a record with contact information for a user of the digital cable host device together with the information identifying the device, the database being populated based on an authorization process for the digital cable host device and the point-of-deployment module, the database being accessed to obtain the contact information based on the information identifying the device contained in the first one of the signals.*

Dependent Claims

All the dependent claims are patentable, since they depend on the independent claims, which are patentable for the reasons set forth above, and because they add further patentable limitations. For example, with regard to Claim 58, the Examiner cites McElhatten 10:30-42 and Hrastar 21:1-67. Applicants respectfully assert that these passages have no relevance to the invention claimed in Claim 58. Claim 58 is directed to the case when the second heartbeat is received, but the host device identifier does not match. See specification 13:24-14:15. This could occur, for example, if the same POD module is being used with a different host device. Again, McElhatten teaches ceasing program transmission when a terminal is turned off in the normal course of operation. No mention is made of checking for matching of a host identifier in a signal

with that in a database record, nor is this deficiency cured by Hrastar; again, the cited passages of Hrastar mention displaying status of cable modems in different colors – nothing in the cited passages mentions any checking for matching of a host identifier in a signal with that in a database record, as in the claim.

Furthermore, with regard to Claim 59, Lu 0026 reads as follows:

[0026] Digital cable set-top box 150 also comprises removable point-of-deployment (POD) module 155, which is provided by the cable service provider. Digital cable set-top box 150 is a "host" device with respect to POD module 155. Digital cable set-top box 150 performs conventional tuning and demodulation of incoming RF signals received from the cable service provider to thereby produce, for example, a stream of MPEG encoded digital data from which video signals may be derived.

This passage, as well as McElhatten and Hrastar, are devoid of any teaching or suggestion that when it is determined *that the information identifying the device, contained in the second signal, does not match the host device identifier from the record, the server communicates with the point-of-deployment module to limit access to the network*, as required by Claim 59.

Similar comments apply to Claims 61 and 62.

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Conclusion

All of the pending claims following entry of the amendments, i.e., Claims 1-9, 29-37, 58, 59, 61 and 62 are in condition for allowance and such favorable action is respectfully and earnestly solicited.

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Examiner's attention to this matter is greatly appreciated.

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Respectfully submitted,



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